

### REMARKS

Claims 1-16 are pending in this application.

The Examiner objected to the disclosure due to informalities. Applicant has amended the specification to correct the informalities and thanks the Examiner for pointing these out.

Applicant has also amended claim 1 to delete “greatly” and to clarify that it is the plane (orthogonal to the light emitting surface of the light emitting diode chip or to an extension of the light emitting surface) that extends off a center of the light emitting surface. Applicant thanks the Examiner for renumbering claims 14-16 as 13-15. Applicant has also added new claim 16, the support for which is found in paragraph [0020] of the specification.

The Examiner stated that the Information Disclosure Statement filed June 17, 2003, failed to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP 609 because Reference No. 1, Document Number 10-22529 from Japan, is “unattainable [sic] as disclosed.” The Examiner further asked applicant to corroborate the document number. The Examiner must not have received the copy of this document which applicant submitted. Applicant resubmits with this response, as a courtesy to the Examiner, a copy of Japanese Patent Publication No. 10-22529, with abstract.

The Examiner points out six objections to the drawings under 37 CFR 1.84(p)(5) because they included reference characters not mentioned in the description. Applicant respectfully disagrees with the Examiner’s interpretation of 37 CFR 1.84(p)(5) because the Examiner has overlooked the sections of the specification explaining the drawing numerals. Applicant has amended the specification, at the beginning of the detailed description of the drawings, to bring attention to the fact that while the same reference numerals may be used across different drawings, the parts referred to by the same numerals in different drawings are the same parts as described in the detailed description.

The Examiner rejected claims 1-4, 8-12 and 16 under 35 USC 103(a) as being unpatentable over the combination of Yamada Japanese Publication No. 11-154766 and Katsura

Japanese Publication No. 05-121785. Applicant respectfully traverses these rejections. The claim rejections are untenable because the combination constructed by the Examiner is not the claimed invention. Thus, the invention could not have been obvious, even in hindsight. Neither Yamada nor Katsura discloses or suggests a device that prevents misrecognition due to incident rays of light from the outside, as in the claimed invention.

Yamada is directed to improving the luminosity of a light-emitting element on an optical axis determined by varying the radii of curvature of the transmissive molding member. The Examiner admits Yamada fails to disclose the convex lens with two different curved surfaces on both sides of a plane orthogonal to an extension of the light emitting surface and extending off a center of the light emitting surface.

The Examiner attempts to supply the missing piece by turning to Katsura. However, Katsura's purpose, as the Examiner admits, is to align the brightest direction of a light emitting element without having to tilt a substrate. This is also not the claimed invention. Katsura's lead frames are inserted into the sealing resin in a state in which a center axis of the entire sealing resin is tilted with respect to a center axis of the lead frame. This achieves the desired goal of aligning the brightest direction of a light emitting element without having to tilt a substrate but discloses nothing about creating total internal reflection of certain light rays from the outside. On the other hand, the applicant's invention prevents rays of incoming light having shallow irradiation angles relative to the resin convex lens subsequently getting reflected back out of the lens and causing a misrecognition that an unlit LED lamp is lit.

The cited references provide no evidence of a motivation to combine their disclosures so as to arrive at the claimed invention. The Examiner states in the Action that it would have been obvious to modify Yamada with Katsura to form an abutment plane that is orthogonal and extends off the center of the light emitting surface of an LED chip to arrive at the claimed invention. The Examiner's alleged motivation is so general in the context of the relevant art as to constitute no more than the reference to a general level of skill in the art found deficient in *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). Under *Lee*, the Examiner

must present *specific* evidence of motivation, not the kind of generalized allegation of motivation relied on in the pending Action:

When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. *See, e.g., McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) (“the central question is whether there is reason to combine [the] references,” a question of fact drawing on the *Graham* factors).

The burden imposed by *Lee* is not an impossible burden, as explained by the court in *In re Thrift*, 298 F.3d 1357, 1364-65, 63 USPQ2d 2002, 2007 (Fed. Cir. 2002), with respect to the references relied on by the Board in that case:

In the present case, the reasoning articulated by the Board is exactly the type of reasoning required by *In re Lee*. Both the examiner and the Board clearly identified a motivation to combine the references, stating that the skilled artisan would have “found it obvious to incorporate the speech input and speech recognition techniques taught by Schmandt into the expert system of Stefanopoulos in order to reduce the need for less user friendly manual keyboard and mouse click inputs.” Decision on Appeal at 5; accord Aug. 7, 1996 Office Action at 3. The motivation to combine the references is present in the text of each reference. The Schmandt reference itself verifies this motivation, stating that “allowing users to remain focused on the screen and keyboard, instead of fumbling for the mouse, would be beneficial in a workstation environment.” Schmandt at 51. Stefanopoulos itself, while not expressly disclosing the use of speech recognition, sets forth the motivation to combine the references, stating that “there are alternative means to select the buttons, including . . . voice-activated transfer means, which may be readily adapted for use with the present invention by those skilled in the art.” ’237 patent, col. 4, ll. 34-38.

The reliance in the pending Action on the alleged routine skill in the art to make the suggested combination comes nowhere close to what *Lee* and *Thrift* require. It is not sufficient to say without evidentiary support, as the Examiner does in the pending Action, “It would have been obvious to modify Yamada with Katsura to form an abutment plane that is orthogonal and extends off the center of the light emitting surface of an LED chip. Thus, said configurations and variations of position within said convex lens will allow for further control of the refraction of outgoing light.” Yamada and Katsura neither use nor suggest all the features in applicant’s claimed invention.

Finally, the Examiner has pointed to no disclosure in Katsura, the alleged evidence of such a motivation, that would have motivated a person of ordinary skill in the art to use its supposed off-center optical axis to prevent rays of incoming light having shallow irradiation angles relative to the resin convex lens subsequently getting reflected back out of the lens and causing a misrecognition that an unlit LED lamp is lit.<sup>1</sup> Applicant's invention may be a straightforward and elegant solution to the problem it addresses, but the cited prior art is devoid of a suggestion to make it. Accordingly, the invention claimed is patentable over the prior art, and claim 1 should be allowed. This logic also disposes of claims 2-4, 8-12 and 16, which depend directly or indirectly from claim 1.

Furthermore, with respect to claim 9, the Examiner asserts that Yamada's Effect of the Invention section makes it obvious in claims 1-4 and 8 to incorporate a plurality of curved surfaces to further control the refraction of outgoing light. However, Yamada merely teaches providing one curved surface on each side of an abutment plane, i.e., only two curved surfaces. Also, the "specific configuration" the Examiner points to in the Yamada's Effect of the Invention merely refers to the configuration in Yamada's claim 1 (paragraph [0009] of the English translation of Yamada), but does not find support in any other configuration of Yamada.

The Examiner rejected claims 5-7 and 14-15 under 35 USC 103(a) as being unpatentable over the combination of Yamada, Katsura, and Katagiri Japanese Publication No. 62-055973. These rejections are also respectfully traversed for the same reasons as above, and because these claims also depend directly or indirectly from claim 1.

In view of the above, each of the claims in this application is in condition for allowance.

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<sup>1</sup> Applicant recognizes that an Examiner cannot search prior art to use in examining a patent application without reading the application and its claims first. That much "hindsight" is permissible and expected in the examination process. However, that is as far as hindsight in the examination process can go. Once the Examiner finds prior art that appears to be relevant based on the limited amount of hindsight that is permissible, *Lee* and *Thrift* require the Examiner to point to *evidence* within the prior art *itself* as to why persons of ordinary skill in the art would have been motivated to combine the disclosures so as to arrive at the claimed invention. Applicant's position rests on the Examiner's failure to produce and rely on objective evidence of motivation in the prior art itself.

Accordingly, applicant solicits early action in the form of a Notice of Allowance.

In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing Docket No. 204552029400.

Respectfully submitted,

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Brian N. Fletcher  
Registration No. 51,683

Morrison & Foerster LLP  
1650 Tysons Boulevard, Suite 300  
McLean, Virginia 22102  
Telephone: (703) 760-7796  
Facsimile: (703) 760-7777